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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/674,186

09/29/2003

Rudolph Nobis

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09/30/2009

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EXAMINER

KASZTEJNA, MATTHEW JOHN

ART UNIT

PAPER NUMBER

3739

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DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/674,186	<b>Applicant(s)</b> NOBIS ET AL.	
	<b>Examiner</b> MATTHEW J. KASZTEJNA	<b>Art Unit</b> 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 September 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 10-13, 15, 16 and 27-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16, 28, 29 and 31 is/are allowed.
- 6) ☒ Claim(s) 10-13, 15 and 27 is/are rejected.
- 7) ☒ Claim(s) 30 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

***Notice of Amendment***

In response to the amendment filed on September 1, 2009, amended claims 1 and 15-16; canceled claims 14 and 22-26; and new claims 27-31 are acknowledged. The indicated allowability of claim 14 is withdrawn in view of the new rejections to U.S. Patent No. 6,533,797 to Stone et al. in view of U.S. Patent No. 6,443,944 to Doshi et al.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10-13, 15 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,533,797 to Stone et al. in view of U.S. Patent No. 6,443,944 to Doshi et al.

**In regards to claims 10, 12-13 and 27**, Stone et al. disclose a medical device comprising: an elongate member; an end effector 35 operatively associated with a distal end of the flexible member; and an elongate handle 32 extending longitudinally from a handle proximal end to a handle distal end, the handle being operatively associated with the proximal end of the flexible member, wherein the flexible member extends from an end of the elongate handle along an axis generally parallel to a longitudinal axis of the elongate handle (see Col. 3, Lines 31-37) and wherein the handle has an outer surface, the handle outer surface extending lengthwise intermediate the handle proximal and

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distal ends, with the handle outer surface having a maximum width portion disposed intermediate the handle proximal and distal ends, wherein the handle outer surface has a length that is greater than the width of the maximum width portion, and wherein the actuator comprises a lever, the lever extending lengthwise alongside at least a portion of the handle outer surface, and wherein the lever extends alongside the maximum width portion of the handle outer surface (see Figs. 3-4). As seen in Figures 7a-d, the device is capable of being held in a number of different positions, and is used so depending upon the user's personal preference. However, Stone et al. are silent with respect to a flexible member and wherein during grasping of the actuator by a single hand the flexible member is in a looped configuration behind the back of the same hand. Doshi et al. teach of an analogous endoscopic apparatus comprising: a flexible member 15; an end effector 10a-b, 11a-b, 12a-b operatively associated with a distal end of the flexible member; and an elongate handle 5 extending longitudinally from a handle proximal end to a handle distal end, the handle being operatively associated with the proximal end of the flexible member, wherein the flexible member extends from an end of the elongate handle along an axis generally parallel to a longitudinal axis of the elongate handle (see Figs. 6-7); wherein the handle is sized and shaped to be gripped by a single hand; wherein the handle comprises an actuator 7a-b operable by the same hand for operating the end effector through the flexible member (see Col. 8, Lines 51-58) with a portion of the flexible member in a looped configuration behind the same hand, and wherein an outer surface of the handle is sized and shaped to be gripped by a single hand and wherein the actuator is disposed on the handle (see Col. 10, Lines

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59-65). Doshi et al. disclose that the flexible member may be up to 50 inches long depending upon the particular application in which the device is to be used (See Col 4, Lines 10-32). It would have been obvious to one skilled in the art at the time invention was made to provide a long flexible member in the apparatus of Stone et al. to provide access to desired treatment sites deep within torturous bodily lumens as taught by Doshi et al. and is well known in the art. Additionally, by providing a long flexible member in the apparatus of Stone et al. the flexible member would be *fully capable of* being looped in any configuration around the hand as recited in the instant claims.

Furthermore, a user would be fully capable of holding the handle with one hand, with the middle finger of that hand free to operate levers 34 and the index finger and thumb of the same hand free to manipulate the flexible member. It is noted that the words “to be” in the claim may be properly interpreted as “capable of,” and “capable of” does not require that reference actually teach the intended use of the element, but merely that the reference does not make it so it is incapable of performing the intended use. Also, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

**In regards to claim 11**, Stone et al. disclose a medical device wherein the end effector is a cutting blade 35.

**In regards to claim 15**, Stone et al. disclose a medical device wherein the lever 34 has a length that is at least half the length of the handle (see Fig. 5).

***Allowable Subject Matter***

Claim 30 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 16, 28-29 and 31 are allowed.

***Response to Arguments***

Applicant's arguments with respect to claims 10-13, 15 and 27 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW J. KASZTEJNA whose telephone number is (571)272-6086. The examiner can normally be reached on Mon-Fri, 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Matthew J Kasztejna/  
Primary Examiner, Art Unit 3739

9/18/09